



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,339	07/23/2001	Wesley D. Lindquist	13212.144	2763

24283 7590 12/13/2004

PATTON BOGGS
1660 LINCOLN ST
SUITE 2050
DENVER, CO 80264

EXAMINER

CHEN, CHONGSHAN

ART UNIT	PAPER NUMBER
----------	--------------

2162

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/911,339

Applicant(s)

LINDQUIST, WESLEY D.

Examiner

Chongshan Chen

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications filed on 18 June 2004. Claims 1-44 are pending in this Office Action.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

MPEP 2106 IV. B.2. (b)

A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. Schrader, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts.

Claims 1-44, in view of the above cited MPEP section, are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application within the technological arts. The use of a computer has not been indicated.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 2162

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 1 recites the limitation "said address" and "said gift certificate recipient" in the 2nd limitations of the claim. There is insufficient antecedent basis for this limitation in the claim.

6. Claim 1 recites the limitation "said user" in the 3rd limitations of the claim. There is insufficient antecedent basis for this limitation in the claim.

7. Claims 8-10 recites the limitation "said data" in line 3 of the claims. There is insufficient antecedent basis for this limitation in the claims.

8. Please correct other lack of antecedent basis problems in claims 1-44.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-15, 18, 20-37, 40 and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Messner (US 6,370,514 B1) in view of Seigel et al. ("Seigel", Pub. No.: US 2001/0051876 A1).

As per claim 1, Messner discloses an automated gift certificate generation system for automatically identifying merchants to generate a gift certificate based on a location, comprising:

Art Unit: 2162

means for receiving gift certificate data that designates a plurality of gift certificate data including at least one of: geographic location, merchant identification, recipient profile, recipient address, monetary value of said gift certificate, product characteristics, mode of delivery, delivery date (Messner, col. 3, lines 4-67);

means for enabling said user to select at least one of said identified merchants (Messner, col. 3, lines 36-39); and

means for generating a gift certificate that defines a monetary amount of said gift certificate and said selected merchant (Messner, col. 3, lines 4-67).

Messner does not explicitly disclose automatically identifying at least one merchant located in an area located proximate at least one of: said address of said gift certificate recipient and said geographic location. Seigel teaches automatically identifying at least one merchant located in an area located proximate at least one of: said address of said gift certificate recipient and said geographic location (Seigel, page 3, [0025]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the gift certificate generation system of Messner by incorporating the limitation of identifying and selecting merchant located in geographic area in the same conventional manner as disclosed by Seigel (page 3, [0025]). The motivation being to identify and buy gift certificate redeemable at a selected merchant that is close to where the recipient is located so that the recipient can easily go to the nearby store to redeem the gift certificate.

As per claim 2, Messner and Seigel teach all the claimed subject matters as discussed in claim 1, and further teach responsive to establishment of a communication connection from a terminal device of said user to said automated gift certificate generation system, for transmitting

Art Unit: 2162

a plurality of user data entry screens, serially to said terminal device to enable said user to input said gift certificate data (Messner, Fig. 3 & 4, col. 3, lines 4-67).

As per claim 3, Messner and Seigel teach all the claimed subject matters as discussed in claim 2, and further teach responsive to receipt of gift certificate data indicative of a location of a recipient profile, for uploading said recipient profile from said location (page 13, [0135]).

As per claim 4, Messner and Seigel teach all the claimed subject matters as discussed in claim 2, and further teach receiving data from said user that defines a radius from said at least one of: said address of said gift certificate recipient and said geographic location as said area located proximate at least one of: said address of said gift certificate recipient and said geographic location (Seigel, page 3, [0025]).

As per claim 5, Messner and Seigel teach all the claimed subject matters as discussed in claim 1, and further teach enabling said user to select a gift certificate from database of gift certificate (Messner, Fig. 3 & 4, col. 3, lines 4-67).

As per claim 6, Messner and Seigel teach all the claimed subject matters as discussed in claim 5, and further teach enable said user to customize said gift certificate (Messner, Fig. 3 & 4, col. 3, lines 4-67).

As per claim 7, Messner and Seigel teach all the claimed subject matters as discussed in claim 1, and further teach enabling said user to select a mode of transmission used to transmit said selected gift certificate to said gift certificate recipient (Messner, Fig. 3 & 4, col. 3, lines 4-20).

As per claim 8, Messner and Seigel teach all the claimed subject matters as discussed in claim 1, and further teach downloading said data indicative of an address of said gift certificate

Art Unit: 2162

recipient via a communication medium from an address book stored on a terminal device of said user (Messner, col. 3, lines 4-20).

As per claim 9, Messner and Seigel teach all the claimed subject matters as discussed in claim 1, and further teach downloading said data indicative of an address of said gift certificate recipient via a communication medium from a web site address book (Messner, col. 3, lines 4-67).

As per claim 10, Messner and Seigel teach all the claimed subject matters as discussed in claim 1, and further teach downloading said data indicative of an address of said gift certificate recipient via a communication medium from a data storage device located remote from said automated gift generation system (Messner, col. 3, lines 4-67).

As per claim 11, Messner and Seigel teach all the claimed subject matters as discussed in claim 1, and further teach generating a map that defines a travel path from said address of said gift certificate recipient to said merchant (Seigel, page 14, [0145]-[0146]).

As per claim 12, Messner and Seigel teach all the claimed subject matters as discussed in claim 11, and further teach generating a list of a plurality of concatenated path segments, each of said plurality of concatenated path segments comprising a definition of a predetermined identified travel path (Seigel, page 14, [0145]-[0146], Mapquest.com).

As per claim 13, Messner and Seigel teach all the claimed subject matters as discussed in claim 12, and further teach generating data indicative of a distance traveled along each of said plurality of concatenated path segments (Seigel, page 14, [0145]-[0146], Mapquest.com).

As per claim 14, Messner and Seigel teach all the claimed subject matters as discussed in claim 13, and further teach generating data indicative of an estimate of a time required to travel

Art Unit: 2162

along each of said plurality of concatenated path segments (Seigel, page 14, [0145]-[0146], Mapquest.com).

As per claim 15, Messner and Seigel teach all the claimed subject matters as discussed in claim 13, and further teach generating a written description of said travel path describing each of said plurality of concatenated path segments and said distance traveled along each of said plurality of concatenated path segments (Seigel, page 14, [0145]-[0146], Mapquest.com).

As per claim 18, Messner and Seigel teach all the claimed subject matters as discussed in claim 13, and further teach generating a display to illustrate said travel path comprising each of said plurality of concatenated path segments and said distance traveled along each of said plurality of concatenated path segments (Seigel, page 14, [0145]-[0146], Mapquest.com).

As per claim 20, Messner and Seigel teach all the claimed subject matters as discussed in claim 1, and further teach storing merchant information in a database; and correlating said received gift certificate data with merchant information stored in said database to generate a list of said identified merchants (Messner, Fig. 3 & 4, col. 3, lines 4-67).

As per claim 21, Messner and Seigel teach all the claimed subject matters as discussed in claim 1, and further teach activating an automated shopping expert program to guide said user through a series of queries to generate data to supplement said received gift certificate data (Messner, Fig. 3 & 4, col. 3, lines 4-67).

As per claim 22, Messner and Seigel teach all the claimed subject matters as discussed in claim 1, and further teach incorporating merchant store operating data comprising at least one of: business hours, telephone number, WEB site address, into said gift certificate (Messner, Fig. 3 & 4, col. 3, lines 4-67).

Claims 23-37, 40, and 42-44 are rejected on grounds corresponding to the reasons given above for claims 1-15, 18, and 20-22.

11. Claims 16, 17, 19, 38, 39 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Messner (US 6,370,514 B1) in view of Seigel et al. ("Seigel", Pub. No.: US 2001/0051876 A1) and further in view of Long (US 6,572,149 B2).

As per claim 16, Messner and Seigel teach all the claimed subject matters as discussed in claim 15, except for explicitly disclosing printing said written description on said gift certificate. Long teaches printing a description of travel path on said gift certificate (Long, Fig. 1, col. 3, lines 39-45). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Messner and Seigel's combined system by incorporating the limitation of printing a description of travel path on the gift certificate in the conventional manner as disclosed by Long (Fig. 1, col. 3, lines 39-45). The motivation being to provide the recipient a map and travel direction to the retail store to redeem the gift certificate. This tells the recipient where the store is located, and allows the recipient to easily go to the store.

Claims 17, 19, 38, 39 and 41 are rejected on grounds corresponding to the reasons given above for claim 15.

Response to Arguments

12. Applicant's arguments with respect to claims 1-44 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 2162


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chongshan Chen whose telephone number is (571)272-4031. The examiner can normally be reached on Monday - Friday (8:00 am - 4:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (571)272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chongshan Chen
December 8, 2004


JEAN M. CORRIELLUS
PRIMARY EXAMINER